

REMARKS

Applicants have carefully reviewed the Application in light of the final Office Action mailed November 18, 2004 ("*Office Action*"). At the time of the Office Action, Claims 1-50 were pending in the Application. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Claims 1-48 Are Allowable

The Examiner rejects Claims 1, 5, 7, 8, 12, 14-17, 21, 23, 24, 28, 30-33, 37, 39, 40, 44, and 46-48 under 35 U.S.C. §103(a) as being unpatentable by U.S. Patent No. 6,415,269, issued to Dinwoodie ("*Dinwoodie*") in view of U.S. Patent 4,894,824, issued to Hemmady et al. ("*Hemmady*"). The Examiner also rejects Claims 6, 9-11, 22, 25-27, 38, and 41-43 under 35 U.S.C. §103(a) as being unpatentable by *Dinwoodie* in view of *Hemmady* and in further view of U.S. Patent 6,556,670 issued to Horn ("*Horn '670*"). The Examiner further rejects Claims 2-4, 13, 18-20, 29, 34-36, and 45 under 35 U.S.C. §103(a) as being unpatentable over *Dinwoodie* in view of *Hemmady* and in further view of U.S. Patent 6,457,045 issued to Hanson et al. ("*Hanson*").

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons. First, neither *Dinwoodie* nor *Hemmady* provides a suggestion or motivation to combine these two references.¹ Second, even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Dinwoodie* and *Hemmady*, whether considered singly, in combination with one another, or in combination with

¹ Much less is there any suggestion to further combine *Horn '670* or *Hanson* with *Dinwoodie* and *Hemmady*.

information generally available to those of ordinary skill in the art at the time of the invention, still fail to disclose all of the elements of independent Claims 1, 17, and 33.

A. No Motivation or Suggestion to Combine *Dinwoodie* and *Hemmady*

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

¹ Note M.P.E.P. 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added).²

In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together various elements of *Dinwoodie* and *Hemmady*. For example, the Examiner merely asserts that it would have been obvious “to incorporate the feature of timing out the connection request if no acknowledgement is received to identify as active link or active participant, as taught by Hemmady, in Dinwoodie’s system, in order to save system resource and avoid the link or port being tied up.” The Examiner goes on to state that “it would be beneficial if the system periodically checks for active participant, if no response from the participant indicating that the participant is not active and disabling the media form that particular inactive participant to allow other callers to joint the conference.” *Office Action*, p. 3.

First, the Examiner fails to identify how the feature of timing out a *connection request* from a “MINT” of *Hemmady* is in any way related to the disabling of media from a device in a multiparty communication session (as recited in Claims 1, 17 and 33). Furthermore, the Examiner fails to describe how the timing out of a connection request from a MINT, as disclosed in *Hemmady*, could in any manner be combined with any particular teaching of *Dinwoodie*. These two references are completely unrelated and there is absolutely no reasoning given by the Examiner as to how the specific teachings of these two references could be combined even if there was a suggestion to combine, which there clearly is not. All

² See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

the Examiner has provided is a statement that modifying *Dinwoodie* (in a way not that is not described by the Examiner) to perform the steps of the present invention (which the Examiner is evaluating in *hindsight*) would be “beneficial.” Nowhere does *Dinwoodie* or *Hemmady* disclose, teach, or suggest the need for a system that “disabl[es] media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.” Thus, the suggestion or motivation required by M.P.E.P. § 2143.01 for the proposed combination of *Dinwoodie* and *Hemmady* does not exist, and the Examiner has failed to identify the source of such suggestion or motivation.

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1, 17, or 33 (or the claims that depend from these independent claims), as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation to combine the cited references. For at least this reason, Applicant respectfully requests reconsideration and allowance of Claims 1, 17, or 33 (and the claims that depend from these independent claims).

B. *Dinwoodie* and *Hemmady* Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 1, 17, and 33

Even assuming for the sake of argument that the cited references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Dinwoodie* and *Hemmady*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, would still fail to disclose each and every element of Claims 1, 17, and 33.

For example, Independent Claim 1 recites the following:

A method for controlling audio content during a multiparty communication session, comprising:

establishing a multiparty communication session involving a plurality of participants, each participant associated with a device;
after establishing the multiparty communication session, prompting the participants to identify themselves as active participants; and
disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.

Claims 17 and 33 recite similar, although not identical, limitations.

Among other aspects of Claim 1, *Dinwoodie* and *Hemmady* fail to describe “after establishing the multiparty communication session, prompting the participants to identify themselves as active participants.” For an alleged teaching of this limitation, the Examiner cites to a portion of *Dinwoodie* discussing a series of steps a bidder must take before commencement of an auction and before being linked to an auction site. However, *Dinwoodie* merely discloses that when a caller wishes to be linked to an auction site, the caller must enter an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller is prompted to enter the password, PIN, and bidder number, the caller still has not linked to the auction site, let alone participated in an established “multiparty communication session involving a plurality of participants.” When the caller enters the requested information the caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not participated in the auction or any multiparty communication session at the time he or she is prompted to enter the requested information. Thus, *Dinwoodie* fails to describe “*after* establishing the multiparty communication session, prompting the participants to identify themselves as *active* participants.”

After seemingly arguing that *Dinwoodie* does disclose this limitation, the Examiner then seems to agree in the next paragraph that *Dinwoodie* does not disclose this limitation since the Examiner states that “*Dinwoodie* does not teach after establishing the multiparty communication session, the participants identify themselves as active participants” However, Claim 1 (and similarly Claims 17 and 33) requires that “after establishing the

multiparty communication session, prompting the participants to identify themselves as active participants.” Therefore, the claim requires that the *prompting* occurs after establishing the multiparty communication session has been established. The Examiner has provided no argument as to how *Dinwoodie* discloses any prompting of *active* participants *after* establishing the multiparty communication session, as described above. Furthermore, the Examiner does not provide any argument as to how *Hemmady* discloses this limitation. There is simply no disclosure of such prompting in *Hemmady*. Therefore, Claims 1, 17, and 33 are at least allowable because neither of the cited references disclose this limitation.

Furthermore, *Dinwoodie* also fails to describe “disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.” The Examiner appears to recognize that *Dinwoodie* does not disclose this limitation (see last paragraph of page 2 of the Office Action); however, the Examiner also argues in the second paragraph on page 2 that it does. *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the auction site and therefore has not participated in the auction, let alone communicated media to other devices in a multiparty communication session. Thus, in *Dinwoodie* there is no “particular device previously used by one of the participants” from which to disable media. Furthermore, there is no “communication of the media from the particular device to other devices in the multiparty communication session” to be terminated. For at least these reasons, *Dinwoodie* fails to describe “disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.”

Moreover, *Hemmady* also fails to disclose this limitation. The Examiner argues that “Hemmady et al. teach if a connection request by the data switches MINTs 11 is ignored or no acknowledgement of a request or the connection is up and active received within a

prespecified time, the MINTs time out or disable the connection request.” This disclosure of the functionality of a MINT does not disclose, teach, or suggest “disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.” First, there is simply no disclosure of identification of active participants in a multiparty communication session. *Hemmady* doesn’t even mention participants in a multiparty communication session, much less identification of active participants.

Also, there is no disclosure in *Hemmady* of disabling media from a device for which no active participant is identified. It appears that the Examiner is asserting that the timing out of a connection *request* is a disclosure of the disabling of media from a device for which no active participant is identified; however, this would require equating a device that was participating in a multiparty communication session and for which an active participant is no longer identified (as disclosed in the present application) to a MINT (as disclosed in *Hemmady*). A MINT is a memory interface module that is part of a metropolitan network and that send connection requests. There is no disclosure that a MINT is a device participating in a multiparty communication from which media is communicated to other devices in the multiparty communication session. Further, even if one were to (for the sake of argument) equate a MINT with one of the claimed devices participating in a multiparty communication session, the MINT terminates its *own* connection *request* if no response to the request is received. This is unlike the present claims where an actual communication (an established connection – not a request) is disabled from a previously participating device by some external device (like the system recited in Claim 33) when that external device is unable to identify an active participant at the previously participating device. This is clearly different than a device timing out (terminating) its own connection *request* when it receives no response to the request.

For at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent Claim 1. For analogous reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent

Claims 17 and 33. Claims 2-16, 18-32, and 34-48 depend from Claims 1, 17, and 33, respectively. Thus, at least because they depend from independent claims shown above to be allowable, Applicants also respectfully request the Examiner to reconsider and withdraw the rejection of Claims 2-16, 18-32, and 34-48.

Claim 49 Is Allowable

The Examiner also rejects Claim 49 under 35 U.S.C. §103(a) as being unpatentable over *Dinwoodie*. Claim 49 recites the following:

A method for handling on-hold endpoints in a conference call, comprising:
 receiving an audio stream from each of a plurality of participants to a conference call;
 receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint;
 prompting each participant to send a reply to a prompt;
 receiving replies from active participants to the conference call; and
 terminating media from devices associated with each participant not sending a reply.

The Examiner concedes that *Dinwoodie* fails to teach or suggest “receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint.” However, the Examiner states that “[p]utting the conference call on-hold by the participant is well known.” *Id.* However, the Examiner has not indicated that “receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint” is well known in the prior art, or that this limitation is disclosed by *Dinwoodie* or any other reference. Applicants therefore respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, Applicants respectfully submit that *Dinwoodie* fails to teach or suggest “receiving replies from active participants to the conference call.” The Examiner apparently assumes that *Dinwoodie* teaches or suggests this element. However, as discussed above with

regard to Claim 1, *Dinwoodie* discusses a series of steps a bidder must take before being linked to an auction site and before commencement of an auction. The steps include entering an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller enters the password, PIN, and bidder number, the caller still has not actively participated in the auction, let alone in a conference call. When the caller enters the requested information the caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not actively participated in the auction or any conference call at the time he or she enters the requested information. *Dinwoodie* specifically discloses that a caller must submit acceptable information prior to being permitted to participate in an auction. *Dinwoodie*, col. 4, ll. 39-41. Thus, at the time the caller submits the requested information, the caller has not actively participated in the auction, let alone in a conference call. For at least these reasons, *Dinwoodie* fails to teach or suggest “receiving replies from active participants to the conference call.”

In addition, Applicants respectfully submit that *Dinwoodie* fails to teach or suggest “terminating media from devices associated with each participant not sending a reply.” As discussed above with regard to Claim 1, *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the auction site and therefore has not participated in the auction, let alone communicated media in a conference call. Thus, in *Dinwoodie* there is no media to be terminated. For at least this reason, *Dinwoodie* fails to teach or suggest “terminating media from devices associated with each participant not sending a reply.”

For at least all of these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claim 49.

Claim 50 Is Allowable

The Examiner also rejects Claim 50 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,178,237, issued to Horn ("*Horn '237*") in view of *Dinwoodie*. Claim 50 recites:

A conference bridge, comprising:
an input buffer operable to receive and buffer audio streams generated by participants of a multiparty communication session;
a cross-connect operable to cross-connect an audio stream from each participant to conference output stream generators for remaining participants;
the conference stream output generator for each participant operable to combine each audio stream received from the cross-connect multiple independently controlled by the participant and to generate a conference output stream for the participant;
an output buffer operable to receive and buffer the conference output streams for transmission to the participant;
and
an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants and to disable audio streams generated by devices associated with non-active participants.

Among other aspects of Claim 50, the combination of *Horn '237* in view of *Dinwoodie* fails to teach or suggest "an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants." The Examiner concedes that *Horn '237* fails to teach or suggest this claim element. Instead, the Examiner cites to a portion of *Dinwoodie* discussing a series of steps a bidder must take before commencement of an auction and before being linked to an auction site. However, as discussed above with regard to Claims 1 and 49, *Dinwoodie* merely discloses that when a caller wishes to be linked to an auction site, the caller must enter an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller communicates the password, PIN, and bidder number, the caller still has not participated in the auction, let alone in a multiparty communication session. When the caller enters the requested information the

caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not participated in the auction or any multiparty communication session at the time he or she is prompted to enter the requested information. *Dinwoodie* specifically discloses that a caller must submit acceptable information prior to being permitted to participate in an auction. *Dinwoodie*, col. 4, ll. 39-41. Thus, at the time the caller submits the requested information, the caller has not participated in the auction, let alone in a multiparty communication session. For at least these reasons, *Dinwoodie* fails to teach or suggest “an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants.”

Furthermore, *Dinwoodie* also fails to teach or suggest “an on-hold handler operable in response to a participant request to communicate with the participants . . . and to disable audio streams generated by devices associated with non-active participants.” *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the auction site and therefore has not participated in the auction, let alone generated audio streams. Thus, in *Dinwoodie* there are no “audio streams generated by devices associated with non-active participants” to be disabled. For at least these reasons, *Dinwoodie* fails to describe “an on-hold handler operable in response to a participant request to communicate with the participants . . . and to disable audio streams generated by devices associated with non-active participants.”

In addition, Applicants submit that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Horn* '237 and *Dinwoodie* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must point to some teaching, suggestion, or motivation in the prior art to combine or modify references to produce the claimed invention. M.P.E.P. §2143.01. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective

evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis in original). Thus, the mere assertion that the teachings of one reference might improve the teachings of another reference, as the Examiner states, does not provide the required suggestion to combine. Moreover, nothing in *Horn* ‘237 or *Dinwoodie* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination. For this additional reason, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

For at least all of these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claim 50.


CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

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